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REMARKS

Claims 1-39 remain the subject application with claims 1, 20, 24, and 35 in independent form. Claims 1, 20, 24, and 35 have been amended. There is full support in the specification as originally filed for these amendments and no new matter is believed to be introduced as a result of these amendments.

Applicant thanks Examiner Augustine for the Interview conducted on December 4, 2006. The discussion relating to the outstanding Office Action and the cited references was much appreciated.

Applicant submits herewith an information disclosure statement under 37 C.F.R. 1.97(c)(1). The cited references relate to the primary reference relied upon by the Examiner and more fully discloses the system relied upon therein. None of the cited references disclose the inventive concepts claimed in the subject application.

Claims 1, 6, 17-24, 27, 28, 31-33 and 35-39 stand rejected under 35 U.S.C. §102(b) as being anticipated by a website for Wink Communications (<http://web.archive.org/web/20001206040800/wink.com/>). As discussed with the Examiner, United States Patent No. 5,848,352 to Wink Communications discloses in greater detail the system disclosed on the website. The Examiner contends that the website discloses each and every feature of the subject invention.

Claims 1, 20, 24, and 35 have been amended to more clearly define the subject invention. Specifically, with reference to claims 1 and 35, the user-selectable region has been amended to recite that the user-selectable region tracks a position of an object in the media without accessing individual frames of the media stream. Claims 20 and 24 have been amended to recite that the user-selectable region tracks a position of the object in the media stream to synchronize the user-selectable region within the layer to the position of

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the object in the media stream without accessing individual frames of the media stream during playback.

As further discussed with the Examiner, Wink Communications merely overlays a form in a layer for creating an interactive television. Wink Communications does not disclose, teach, or suggest, defining the user-selectable region to track a position of the object in the media stream without accessing individual frames of the media stream. On the contrary, Wink Communications does not track the position of the object at all and is fixed to one location within the frame. Thus, Wink Communications does not disclose each and every feature of the subject invention as now claimed.

Therefore, the §102(b) rejection is believed to be overcome and claims 1, 20, 24, and 35 are believed to be allowable. Claims 6, 17-19, 21-23, 27, 28, 31-33 and 36-39, which depend directly or indirectly from these independent claims, are also believed to be allowable.

Claims 2-5, 7-13, 15, 16, 25, 26, 29, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the website for Wink Communications in view of an article to Bove et al. titled Adding Hyperlinks to Digital Television.

Applicants respectfully contend that the Examiner has failed to establish a *prima facie* case of obviousness. When applying 35 U.S.C. §103, the following tenets of patent law *must* be adhered to:

(A) The claimed invention *must be considered as a whole*;

(B) The references *must be considered as a whole* and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed *without the benefit of impermissible hindsight* vision afforded by the claimed invention; and

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(D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). The law is further set forth in the Manual for Patent Examining Procedure (MPEP) at §2142 “Legal Concept of *Prima Facie* Obviousness”.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002), citing *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000).

The Court of Appeals for the Federal Circuit (CAFC) recently reiterated the requirements required for making an obviousness determination in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). The CAFC stated that most inventions arise from a combination of old elements and each element may often be found in the prior art; however, mere identification in the prior art of each element is *insufficient* to defeat the patentability of the combined subject matter as a whole.

The CAFC also stated that to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, a basis must be articulated. This requires the Examiner to explain the reasons one of ordinary skill in the art would have

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been motivated to select the references and to combine them to render the claimed invention obvious. The “motivation-suggestion-teaching” requirement protects against *the entry of hindsight* into the obviousness analysis, a problem which §103 was meant to confront.

In *Alza Corp. v. Mylan Laboratories Inc.*, 80 USPQ2d 1001 (Fed. Cir. 2006), the CAFC further stated that the basis includes (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. The CAFC stated that legal determinations of obviousness should be based on evidence rather than on mere speculation or conjecture.

The CAFC continued “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decision making, as it is in §103.”

Specifically, Applicants submit that the Examiner has not established a *prima facie* case of obviousness because 1) there is no suggestion or motivation to modify the reference or to combine reference teachings, 2) impermissible hindsight is relied upon in making the combination, and 3) the prior art references when combined do not teach or suggest all the claim limitations.

As described above, Wink Communications merely discloses a form that is an overlay on a frame. The form may be designed with various buttons or graphics corresponding to an object. (*See page 6*). Further, the form is designed separate from the

media stream and hence the user-selectable region does not *track a position of the object*. (See page 10). As such, the user-selectable region does not synchronize to the position of the object during playback of the media stream.

Referring to Bove et al., merely a system for adding hyperlinks by editing the video frame by frame is disclosed. The Examiner cites to page 3, paragraph 4 for such a suggestion. However, page 3, paragraph 4 states:

The user selects a single representative frame from the sequence...and uses the mouse to highlight representative pixels for each desired object. When the author has finished labeling pixels in the frame, our system estimates the location of these pixels *within each of the remaining frames*...{emphasis added}

In other words, Bove et al. provides a system that accesses the media stream frame by frame and defines the user-selectable region for each frame of the media stream. In Bove et al., referring to the Abstract, page 1, the author identifies an object in a “frame of video” and the system generates a segmentation mask for that frame and *following frames*, i.e., frame by frame editing. Bove et al. does provide for automated outlining of items in the frames because they don’t “require manual *outlining in every frame*.” (See page 3, 3rd paragraph). Moreover, Bove et al. identifies the main problem with using frame by frame editing which is the computational demands of segmentation are quite high. (See page 11, 1st paragraph).

The subject invention allows for quickly and efficiently creating the links in any media or video stream without having to edit the video stream frame by frame. The subject invention may even allow for creating these links in live broadcast television on a short delay because the links can be created quickly. As discussed in detail in the Background of the Invention section, specifically paragraphs [0007] and [0008], of the originally filed specification, frame by frame editing is well known. Also well known

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are the drawbacks to such methodologies. For example, a half-hour media stream would have 3,600 frames and the system disclosed in Bove et al. would require each of the 3,600 frames to be edited. Independent of whether the frames are edited manually or automatically, the resources to perform such an operation are large.

Therefore, the subject invention provides a novel and unique method and system for defining the user-selectable regions without accessing individual frames of the media stream. The user-selectable regions can be defined quickly and seamlessly without having to edit individual frames of the media stream. The resources required to perform the subject invention are reduced as compared to the system disclosed in Bove et al.

Applicant respectfully submits that there is teaching, suggestion, or motivation to combine the Wink Communications website with Bove et al. Specifically, the website is directed toward displaying a form as an overlay separate from the media stream, whereas Bove et al. is directed to frame by frame editing of a media stream. Thus, a person of ordinary skill in the art faced with the problems overcome by the subject invention would not have combined the teachings of the Wink Communications website with the teachings of Bove et al.

Further, the combination of the Wink Communications website with Bove et al. does not disclose each and every feature. Specifically, the limitation of defining the user-selectable region to track a position of the object in the media stream without accessing individual frames of the media stream is not disclosed, taught, or suggested. The Wink Communications website does not track the position of the object, it merely discloses an overlay, and Bove et al. discloses defining the position using frame by frame editing. As such, the combination does disclose, teach, or suggest, the novel and unique limitation.

In view of the above, the §103 rejection should be withdrawn and claims 2-5, 7-

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13, 15, 16, 25, 26, 29, and 30 are believed to be allowable. Claims 14 and 34, which depend directly or indirectly from independent claims 1 and 24, are also believed to be allowable.

Accordingly, it is respectfully submitted that the Application is presented in condition for allowance, which allowance is respectfully solicited. The Commissioner is authorized to charge our Deposit Account No. 08-2789 for any fees or credit the account for any overpayment.

Respectfully submitted,

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